

Application No.: 09/827,630

Docket No. D02316-04

REMARKS**A. Status of the Application**

The Examiner noted a defects in the oath and specification with respect to a priority claim to earlier filed applications. With this amendment the Applicant has amended the specification to include the proper reference, and will provide a properly amended oath prior to allowance so that priority might be officially granted.

Claims 1-6 were held to claiming non-statutory subject matter under 35 U.S.C. § 101. Applicant has amended these claims in accordance with the Examiner's recommendations.

Claims 1-3, 5, 7-9 and 11-13 were found to be anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,865,675 ("Epstein") by the Examiner.

The Examiner also found Claims 6 and 10 unpatenable under 35 U.S.C. § 103(a) over Epstein, and Claims 4 and 14 unpatenable under 35 U.S.C. § 103(a) over Epstein in view of U.S. patent No. 6,157,719 (Wasilewski").

Finally, the Examiner also raised a double patenting objection with respect to Claims 2 and 8, and Claims 3 and 9. Applicant has canceled Claims 8 and 9.

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B. Objections to Specification

The Examiner noted that the specification lacked reference to the applications from which the present application was claiming priority. Applicant has remedied this defect by requesting that a new paragraph [0001] be inserted into the specification. As shown below, this substitute paragraph [0001] contained the requisite references:

[0001] This is a continuation-in-part of U.S. Application Ser. No. 09/580,303 filed on May 26, 2000, which itself claimed priority from provisional applications 60/0158491 (filed November 12, 1999), 60/165094 (filed November 12, 1999), and 60/174037 (filed December 30, 1999).

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C. Rejection of the Claims under 35 U.S.C. § 101

Claims 1-6 were held to claiming non-statutory subject matter under 35 U.S.C. § 101. In particular, the Examiner contended that Applicant's use of the term "content receiver" read on an operating system, and was therefore judged to be non-statutory. In making this rejection, the Examiner noted that if Applicant were to substitute the term "set top box" for "content receiver", this rejection could be overcome.

With this response, the Applicant has taken the advice offered by the Examiner and amended Claims 1-6 so that they now make reference to a "set top box" as opposed to a "content receiver. Applicant has requested that similar amendments be made to Claims 7, 12 and 13.

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D. Rejections of the Claims under 35 U.S.C. § 102

The Examiner rejected claims 1-3, 5, 7-9 and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Epstein. Epstein was filed on March 25, 1999, and claimed priority to a Provisional Application that was filed on July 14, 1998. The instant application was filed on April 6, 2001, and can rightfully claim priority to several Provisional Applications, the earliest of which was filed on November 12, 1999 (Applicant notes that defects in the oath need to be corrected before such priority could be officially recognized). Accordingly, on its face Epstein qualified as prior art to the Applicant's application under 35 U.S.C. § 102(e).

The attached 37 C.F.R. § 1.131 declaration of the sole inventor, Eric J. Sprunk, establishes that the instant invention was conceived and reduced to practice prior to the filing date of Epstein Provisional Application. Particularly, the attached declaration establishes that the subject matter of the claimed invention of the above application was memorialized and shared with other General Instrument employees no later than June 2, 1998. Accordingly, the attached declaration antedates Epstein, thus removing it as prior art. See, MPEP 715. Hence, Applicant respectfully requests the above rejection under Jones be withdrawn.

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E. Rejection of the Claims under 35 U.S.C. § 103

Claims 1-3, 5, 7-9 and 11-13 were found to be anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,865,675 ("Epstein") by the Examiner. Applicant has canceled Claims 8 and 9 with this response, so the rejection with respect to those claims need not be addressed.

The above rejection of Claims 1-3, 5, 7 and 11-13 were predicated upon the Epstein reference. The attached § 1.131 declaration of the sole inventor, Eric J. Sprunk, establishes that the invention of the above application was conceived and reduced to practice prior to the filing date of Epstein. In this response the Applicant has provided documentation attesting to the fact that Epstein should not be considered as prior art to the present invention. Consequently, the Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. § 103 rejections, as Epstein is not prior art to the instant application.

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F. Double Patenting

Examiner raised a double patenting objection with respect to Claims 2 and 8, and Claims 3 and 9. Applicant has canceled Claims 8 and 9, and thereby eliminated the basis for this objection.

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CONCLUSION

The presently amended claims are believed to be in condition for allowance in light of the amendments requested by the Applicant and the Declaration of Eric J. Sprunk (submitted with this response). Applicant respectfully requests that they be passed to allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby requests such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

By: 

Robert P. Marley
Registration No.: 32,914

Motorola Connected Home Solutions
101 Tournament Drive
Horsham, PA 19044
(215) 323-1907